

Attorney Docket No.: KUZ0029US.NP
Inventors: Shirai et al.
Serial No.: 10/575,562
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REMARKS

Claims 1-7 are pending in the instant application. Claims 1-7 have been rejected. Claims 1 and 4 have been amended. No new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Objection to Claim 1

Claim 1 has been objected to as the Examiner suggests that pts.wt is non-standard. Therefore, in accordance with the Examiner's suggestion, Applicants have amended claims 1 and 4 to recite parts by weight. Withdrawal of this objection is respectfully requested.

II. Rejection of Claims under 35 U.S.C. 112, second paragraph

Claims 1-7 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, with respect to claim 1, the Examiner suggests that it is not clear what type of proportion is intended to be claimed. Further, the Examiner suggests that it is unclear to what the proportions are relative by

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weight. The Examiner also suggests that the term "i.e." is unclear.

In addition, with respect to claim 4, the Examiner suggests that it is unclear what the 10-80 pts. wt. is relative to. Further, the Examiner suggests that the term "blend amount" is unclear.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended claims 1 and 4 to recite parts by weight relative to the total weight of the three ingredients of polyisoprene, a styrene/isoprene/styrene polymer and solid polyisobutylene. In addition, Applicants have replaced the term "i.e." with --of--. Further, Applicants have replaced the term "blend amount" with --content--.

No new matter is added by these amendments.

Withdrawal of this rejection is respectfully requested.

III. Rejection of Claims under 35 U.S.C. 103(a)

Claims 1-3, 5 and 6 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Lipman (U.S. Patent Application Publication No. 2004/0243041) as evidenced by Yano et al. (U.S. Patent 5,556,636) and by Tabar et al. (U.S. Patent 4,419,480).

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The Examiner has acknowledged that the primary reference of Lipman does not explicitly embody the claimed invention with sufficient specificity to be anticipatory. However, the Examiner suggests that it would have been prima facie obvious to one of ordinary skill in the art at the time the claimed invention was made to combine all the ingredients as instantly claimed based on the teachings of Lipman to produce the instant invention. The Examiner relies upon Yana to suggest that each of the instantly claimed components is well known in the adhesive arts. The Examiner suggests that Lipman teaches that the polyisoprene, styrene-isoprene-styrene copolymer and isobutylene adhesive components are equivalent and interchangeable. The Examiner refers to MPEP 2144.06 in support of the suggestion that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to used for the very same purpose. The Examiner refers to MPEP 2144.07 in support of the suggestion that selection of known materials based on their suitability for their intended uses is also prima facie obvious.

Tabar is suggested by the Examiner to teach that the high molecular weight polyisobutylene taught by Lipman has a

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viscosity average molecular weight of not less than 900,000, thus reading on claim 2.

Claims 1, 4 and 7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Lipman in view of Kuniya et al. (U.S. Patent Application Publication No. 2002/0045043. The Examiner suggests that Lipman teaches the pressure-sensitive adhesive of instant claim 1 as applied above. Further, with respect to claim 4, the Examiner suggests that it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to include a high proportion of tackifier in the compositions taught by Lipman, in order to improve the adhesive force of the composition as taught by Kuniya et al. With respect to claim 7, the Examiner suggests that it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to laminate the adhesive composition of Lipman onto a backing, which is covered by a liner. The Examiner suggests that one would be motivated to do so to produce a marketable final product comprising the adhesive composition such as the pressure-sensitive adhesive sheets of Kuniya et al.

Applicants respectfully traverse these rejections.

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At the outset, it is respectfully pointed out teachings of Lipman are directed to facial masks for use in wound management. In contrast, the present invention is aimed at providing pressure-sensitive adhesive compositions which have favorable tackiness irrespective of whether the temperature of the surrounding air is high or low, long-term storage stability, retain the necessary cohesive force and do not irritate the skin. A list of possible exemplary materials disclosed by Lipman for inclusion in a fluid absorbing adhesive for facial masks is in no way suggestive of the suitability of these materials in a pressure-sensitive adhesive composition wherein tackiness irrespective of whether the temperature of the surrounding air is high or low, long-term storage stability, retaining of the necessary cohesive forces and no irritation of the skin are desired. Accordingly, Applicants respectfully disagree with the Examiner that the cited prior art establishes prima facie obviousness since contrary to the Examiner's suggestion, the compositions of Lipman and those of the instant invention are **not** taught to be useful for the same purpose.

Further, no where do the cited combinations of references expressly teach or suggest a pressure-sensitive

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adhesive composition which comprises three ingredients of polyisoprene, a styrene/isoprene/styrene copolymer, and solid polyisobutylene, in a proportion of (10-60)/(10-50)/(20-60) parts by weight relative to the total weight of the three ingredients and further contains a non-solid isobutylene polymer and a tackifier, characterized in that the amount of the non-solid isobutylene polymer is 1 to 30 parts by weight, excluding 30 parts by weight, per 100 parts by weight of the sum of the three ingredients of polyisoprene, a styrene/isoprene/styrene copolymer, and solid polyisobutylene. Nor do the cited combinations of references suggest the unexpected properties of the claimed combination of elements in both favorable tackiness and necessary cohesive force shown in the Examples of the instant application. The Examiner is respectfully directed to the teachings in the specification at pages 17 through 31 wherein it is shown that exemplary pressure-sensitive adhesives comprising the specific claimed elements exhibited unexpected favorable or very favorable tackiness and stickiness as compared to pressure-sensitive adhesives prepared with alternative components known in the adhesive arts and included in the listings of possible exemplary components disclosed by the cited references. The

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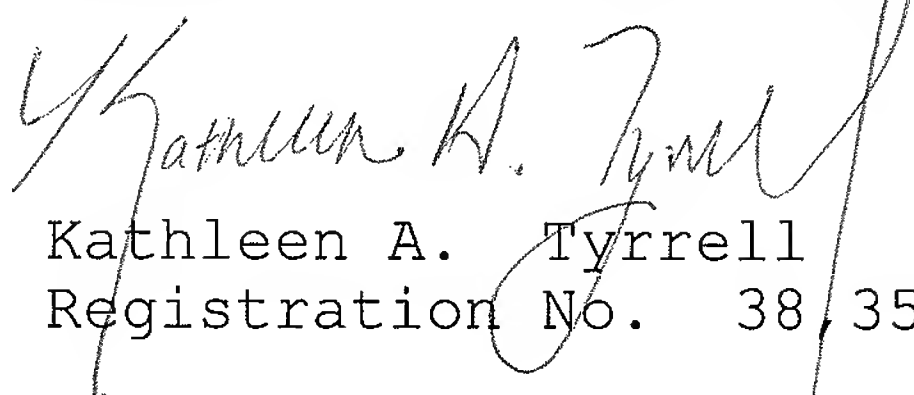
criticality of the specific claimed components in achieving favorable tackiness and stickiness demonstrated in the instant specification clearly overcomes any prima facie case of obviousness over the combinations of cited references.

Withdrawal of these rejections under 35 U.S.C. 103(a) is respectfully requested.

IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,


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